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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,736	05/18/2005	Junichi Inagawa	B 520	9426

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EXAMINER
HOBBS, LISA JOE

ART UNIT	PAPER NUMBER
1657	

NOTIFICATION DATE	DELIVERY MODE
06/21/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

melissa.leck@ge.com

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/535,736	**Applicant(s)** INAGAWA ET AL.	
	Examiner Lisa J. Hobbs	**Art Unit** 1657	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 April 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on *12 April 2010*. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☒ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-15 and 18-21*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Lisa J. Hobbs/
Primary Examiner
Art Unit: 1657

Continuation of 3. NOTE: Applicants have added a second step to the instant method under examination wherein the biomolecules are not merely contacting an immobilization substrate but they now also have a limitation to actively immobilize the biomolecules to the immobilization substrate through a particular type of binding. This has not previously been presented to be searched or discussed for additional considerations such as new matter, written description, enablement, scope of enablement and predictability to one of skill in the art. The specification has not been examined to determine the support for the active method step comprising the actual requirement for immobilization under the specific limitations. Previously, the method required contacting elements and allowing certain bonds to form, but the currently proposed limitation of active immobilization via specific linkages was not discussed..

Continuation of 11. does NOT place the application in condition for allowance because: the request for reconsideration only applies in part to the active claim set, the set submitted by applicant on 08 September 2009. Applicants continue to assert that the prior art does not teach contacting the elements, a biomolecule and a substrate and allowing them to form bonds between tags and non-tag groups wherein the bonds are formed between a polypeptide of interest and an immobilization substrate. However, Nock et al. teach three concomitant bindings between a polypeptide and another substituent, which could be an immobilization substrate. They teach a construct "wherein W is a trivalent core component; L.sup.1, L.sup.2 and L.sup.3 are independently linking groups; X is a non -covalent polypeptide tag binder; Y is a photoactivatable covalent linking group; and Z is a protected or unprotected covalent crosslinking group. In this particular example, a trifunctional linking group is depicted having three functional groups (X, Y and Z) attached via linkers (L.sup.1, L.sup.2 and L.sup.3) to a central core (W). The first functional group is one which provides a non -covalent association with a targeted polypeptide or a polypeptide of interest. For example, the trifunctional linking group can form a non -covalent association complex with a polypeptide having a suitable tag (e.g., a his-tag). The second functional group can then establish a covalent linkage to the polypeptide at a site which is proximate to the initial non -covalent association site. One of skill in the art will appreciate that although the polypeptide is shown as a relatively small circle (relative to the size of the trifunctional crosslinking group), in fact the polypeptide in most embodiments is quite large relative to the crosslinking group. Nevertheless, the site for covalent attachment of functional group Y will depend on the lengths and flexibility of the linking groups L.sup.1 and L.sup.2. Typically, the site for covalent attachment of Y to the polypeptide will be within about 50 .ANG. of the site of non -covalent association. Release of the non -covalent functional group (X) from the polypeptide provides a polypeptide having a covalently bound trifunctional crosslinking group. In subsequent steps, functional group Z of the polypeptide-crosslinking group composition can be used, for example, to attach a suitable label to the polypeptide, or to immobilize the polypeptide on a suitable support." [0100]. They even discuss how one locates a suitable proximal site for the second and third linkages between the polypeptide and the other substituent.